



Paper 5

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SEP 26 2002

OFFICE OF PETITIONS

In re Application of
Huff et al.
Application No. 09/731,571
Filed: December 7, 2000
Attorney Docket No.2585-006

**DECISION ON PETITIONS
37 CFR 1.137(b) AND 1.47(a)**

This is a decision on the petitions filed under 37 CFR §1.137(b) and §1.47(a) both filed June 10, 2002. The petition to revive under 37 CFR §1.137(b) will be addressed first.

The petition to revive under 37 CFR 1.137 (b) is **dismissed**.
The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) Months from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)". This is **not** final agency action within the meaning of 5 U.S.C. §704.

This above-identified application became abandoned for failure to file a response to a Notice to file Missing Parts of a Nonprovisional Application which was mailed on January 22, 2001. The Notice to File Missing Parts set an extendable two (2) month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on March 23, 2001. This decision precedes the mailing of a Notice of Abandonment.

This petition is **DISMISSED**.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was intentional"; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03 (c)(III)(C) and (D).

The instant petition lacks item (1). The required reply is a grantable rule 47 petition which petitioner has failed to provide.

37 CFR 1.47(a)

The petition to accord rule 47 status is **DISMISSED**.

The above-identified application was filed on December 7, 2000, without an executed oath or declaration. Accordingly, on January 22, 2001, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a \$130.00 surcharge for its late filing.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1). Pursuant to petitioner's request deposit account 18-1579 has been charged the \$130.00 petition fee pursuant to 37 CFR 1.17(h) and the \$130.00 surcharge for late filing of the declaration pursuant to 37 CFR 1.16(e).

As to item (1), Rule 47 applicant has failed to show that co-inventor Michael Gazillo was ever presented with a copy of the application papers. Before a refusal can be alleged, applicant must demonstrate a bona fide attempt was made to present a copy of application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). Rule 47 applicant only indicates Gazillo was contacted and has refused to sign numerous mailings. Rule 47 applicant needs to establish what the "multiple mailings" consisted of. Did the mailings consist of the entire application? Rule 47 applicant must also provide more specific facts. If the entire application was submitted for Gazillo's execution, rule 47 applicant should provide the date and the method of delivery to inventor Gazillo. However, if the application papers (specification, including claims, drawings, and oath or declaration) have not been presented to inventor Gazillo, rule 47 applicant must do so before rule 47 status will be granted.

As to inventors Jack Cashman and Howard Pfeffer rule 47 applicant has failed to provide sufficient evidence to establish "diligent effort" was made to locate inventors Cashman and Pfeffer. Petitioner merely states the inventors were not located after "multiple delinquent (sic) efforts".

Applicant should present copies of documentary evidence that support a finding that the non-signing inventor could not be found or reached and the steps taken to locate the non-signing inventor. If applicant provides sufficient evidence that diligent effort has been made to locate the inventor and inventor can not be located, 47 applicant is not required to send a copy of the application.

Rule 47 applicant indicates one of the inventors is now employed by a competing company. The inventors employment with a competitor does not waive the requirements

of rule 47. See MPEP 409.03(b).

Upon renewed petition, rule 47 applicant must demonstrate application papers were sent to inventor Gazillo and what efforts which rise to "diligent effort" were used to locate inventors Cashman and Pfeffer.

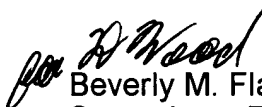
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries concerning this matter should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.


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